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10/059,973	01/30/2002	Shi-Chao Hong	04621.1-P-5909	5871

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EXAMINER

FISCHMANN, BRYAN R

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 02/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/059,973

Applicant(s)

HONG

Examiner

Bryan Fischmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 22, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04/22/2002 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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*Specification*

1. The abstract of the disclosure is objected to because of the following:
  - A) The abstract uses legal terms such as “comprises” (see MPEP 608.01(b)).
2. The disclosure is objected to because of the following:
  - A) The following recited phrases are unclear, awkwardly worded, and/or grammatically incorrect:

Note: The specification, including the abstract, is considered to be replete with awkward, unclear and grammatically incorrect wording. Therefore, a comprehensive listing of all objectionable wording cannot be guaranteed. Examples of wording problems will be given in many cases below in order to assist the Applicant’s understanding as to what is considered objectionable, and in other cases, so as not to impose an undue burden on the Examiner to explain every instance of objectionable wording, the objectionable lines only will be given without a detailed explanation of what is objectionable. Applicant is requested to thoroughly review the disclosure for all objectionable wording and correct, as appropriate.

1) Line 3 of the abstract, lines 5 and 6 of sheet 1, lines 2 and 21 of sheet 2, lines 15, 16 and 26 of sheet 3 and lines 5 and 15 of sheet 4 recites “skateboard shoe”. This term is objected to, as Applicant has disclosed a “skate” and not a “skateboard shoe”. While Applicant may be his own lexicographer, a term may not be used contrary to it’s accepted meaning. Recommend that the term “skateboard shoe” be replaced with “skate” wherever this term appears.

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2) Lines 7 and 8 of the abstract recites "Thereby, the buckle moves straightly along the guide grooves of the lower cover".

This recitation is considered awkward.

This recitation is considered better worded "Thereby the buckle slides along the linear guide grooves of the lower cover".

3) To be grammatically correct, the word "an" should not be present on line 9 of the abstract.

4) Line 11 of sheet 1 recites "Skating is an exercise consuming a large amount of heat, but is funny".

The meaning of this recited phrase is considered unclear, as well as awkwardly worded.

This recitation, as best understood, is considered to be better worded "Skating is an exercise consuming a large amount of energy".

5) Lines 12 and 13 of sheet 1 recites "In general, one of the commercial skate shoes can be assembled with the shoes worn by the user".

The meaning of this recited phrase is considered unclear.

6) Line 13 of sheet 1 recites "This kind of skate shoes have a front seat 1...".

It is considered unclear what the reference number in this recited phrase is referring to, as all drawing figures in this application disclose the Applicant's invention. In other words, there are no "related art" figures in the Application. Note that this recitation is in the

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“Description of Related Art” section of the application, which implies Applicant is describing “related art”.

Also, to be grammatically correct the word “shoe” in the above recitation should not be present and the word “have” should instead be “has”.

7) Lines 15 and 16 of sheet 1 recites “skateboard”. This recitation should instead be “skate”.

8) The sentence beginning “When it is desired...” on line 15 of sheet 1 is an incomplete sentence.

To be grammatically correct, this sentence should be combined with the following sentence beginning “A stud can be...” on line 16 of sheet 1.

9) On line 16 of sheet 1, to be grammatically correct, the recitation of “can be tighten” should instead be “may be tightened”.

10) When read in context, the word “ in advance” on line 17 of sheet 1 appears unnecessary.

11) Lines 19 and 20 of sheet 1 recites “However, such kind of skate shoe still has some defects necessary improved”.

The meaning of this recitation is considered unclear.

As best understood, this recitation is believed better worded “However, this kind of skate has some shortcomings which may be improved upon”.

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- 12) On line 14 of sheet 2, the word “deengagement” should instead be “disengagement”.
- 13) On line 24 of sheet 2, the word “the” should not be present.
- 14) Line 1 of sheet 3 is awkwardly worded (“exactly”)
- 15) Line 6 of sheet 3 (awkward)
- 16) On line 10 of sheet 3, as best understood, the words “likes a” should be replaced by the words “resembles”
- 17) Line 15 is considered unclear (“transversely arranged”)
- 18) To be grammatically correct, on line 20 of sheet 3, the word “is” should be replaced by the word “are”
- 19) Line 29 of sheet 3 (awkward - “assembly way”)
- 20) On line 9 of sheet 4, the word “deengaged” should instead be “disengaged”
- 21) Line 13 of sheet 4 is considered awkward (necessary size)
- 22) The paragraph on sheet 4 from lines 15-19 seems redundant in that it seems to repeat what was just stated in lines 5-14 of sheet 4.

B) The description of related art on sheet 1 is considered unclear. It is requested Applicant add a sketch illustrating the related art without adding new matter.

Also, it appears Applicant is describing relevant prior art. It is therefore requested Applicant submit any known prior art corresponding to the description of related art on sheet 1 on an Information Disclosure Statement.

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C) The "Brief Description of the Drawings" section on sheet 2 of the specification is missing drawing descriptions for Figures 1A and 4A.

Also, Figure 1 appears to be a "bottom view" of the skate. If this is correct, it is requested Applicant indicate this in the drawing description for Figure 1 on sheet 2.

### *Drawings*

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign mentioned in the description: "A". Correction is required.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign not mentioned in the description: "A1". Correction is required.

5. Figures 3-A and 3-B are objected to, as the quality of the drawing is insufficient to clearly see the relationship of illustrated parts. For example, the "interrelationship" of reference numbers 324, 31, 322, 321, "P", 313 and 32 is unclear in these figures, as the "resolution" of the drawing figure is insufficient to clearly see each of these parts.

Also, it is unclear why reference number 33 is in parenthesis on Figure 3-A.

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*Claim Objections*

6. Claims 1-4 are objected to because of the following:

Note: The claims are considered to be replete with objectionable matter. Therefore, a comprehensive listing of all objectionable matter cannot be guaranteed. Applicant is advised to review all claims for objectionable matter.

A) The term "skateboard shoe" recited on line 1 of claims 1-4, lines 21 and 23 of claim 1 and line 2 of claim 3 is objected to for reasons already set forth in this Office Action.

B) Line 4 of claim 1 recites "...the buckle structure is formed a round lower cover...".

This recitation is considered to be awkwardly worded, as well as not being consistent with Figure 1.

The "buckle" is best understood to be reference number 32 of Figure 1 and the "round lower cover" is best understood to be reference number 31 of Figure 1.

In light of this, the above recitation is considered to be better and more accurately worded:

"the buckle is installed in a round lower cover".

C) The word "locked" on line 5 of claim 1 is considered awkward, when read in context.

D) On line 7 of claim 1, the word "exactly" appears unnecessary.

E) The recitation of "...the elliptical hole is exactly matched to the locking shaft seat of the lower cover..." on lines 12 and 13 of claim 1 is considered awkwardly worded and a bit unclear.



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As best understood, this recitation is better and more clearly worded “the elliptical hole is aligned with the locking shaft seat of the lower cover so that the locking shaft seat is within the elliptical hole”.

F) Lines 13 and 14 of claim 1 recites “...thereby, the buckle moves straightly along the guide grooves of the lower cover”.

This recitation is considered awkward.

This recitation is considered better worded “Thereby the buckle slides along the linear guide grooves of the lower cover”.

Also, the “period” at the end of this recitation should not be present.

G) To improve wording, the word “an” should not be present on line 14 of claim 1.

H) To be grammatically correct, the word “protrudes” on line 15 of claim 1 should not be plural.

Similarly, on the same line, the words “downwards”, “extends” and “inwards” also should not be plural.

I) Lines 15 and 16 of claim 1 recites “...the engaging teeth is exactly engaged to the teeth bank...”.

As best understood, this recitation is better worded “the engaging teeth are engaged with the teeth bank”.

Also, a better term for the term “teeth bank” is “tooth bank”.

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J) To improve wording, the word "passing" on line 17 of claim 1 should be replaced with the words "which passes".

K) Line 19 of claim 1 recites "...the spring resists against another side of the front seat".

As best understood, this recitation is better worded "the spring is in contact with the front seat".

L) Claim 3 recites "...wherein an inner side of an shoe surface is distributed with a plurality of elastic pads...".

This recited phrase is objected to, as being awkwardly worded and inconsistent with Figure 1.

As best understood, the "elastic pads" are reference character "A21" of Figure 1.

In light of this, the above recitation is believed better and more correctly worded "wherein lateral wings of the rear seat have elastic pads installed in holes in the lateral wings".

M) Claim 4 is considered to be awkwardly worded.

*35 USC § 101*

7 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-4 are rejected under 35 USC 101 due to the following:

A) Line 20 of claim 1 recites "...wherein the user presses the buckle from a lateral side...".

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Note that this recitation positively recites "the user".

A "user" is non-statutory subject matter under 35 USC 101.

To overcome this rejection, the term "user" should only be recited functionally.

For example, the above recitation can be worded to overcome the 35 USC 101 rejection as follows:

"Wherein the buckle may be pressed by a user from a lateral side".

B) Note that line 3 of claim 3 also positively recites "a user's rear heel".

To overcome this rejection, it is recommended that the portion of line 3 of claim 3 following the words "elastic pads" be deleted.

#### ***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant regard as their invention.

Note: The claims are considered to be replete with unclear matter. Therefore, a comprehensive listing of all unclear matter cannot be guaranteed. Applicant is advised to review all claims for unclear matter.

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A) Lines 4 and 5 of claim 1 recites “a lower center of the front seat”. The specific location being described by the words “a lower center” in the above recitation is considered unclear, since the front seat has a somewhat “irregular”, or non-symmetric shape, it is not considered obvious what constitutes the “lower center” of the front seat. Note that the term “lower center” does not correspond to nomenclature associated with a reference number, or character which could be associated with a specific location on the drawing figures.

Note that Section 608.01 (o) and 2173.05(a) of the MPEP requires that nomenclature used in the claims be apparent from the specification and drawings, unless it is apparent from the prior art.

Note that Section 608.01(g) of the MPEP also recites “The description is a dictionary for the claims and should provide clear antecedent basis for all terms used in the claims”.

B) Line 14 of claim 1 recites “one inner end of the buckle”.

This recitation is considered unclear, as the recitation implies there is more than one “inner end”, leaving unclear what portion of the buckle comprises “one inner end”.

The “buckle” is best understood to be reference number 32 of Figure 1.

C) Claim 2 recites “...the lower cover is installed with a hook...(and)...coupled to a lower end of the front seat by hooking”.

The “hook” is best understood to be reference number 314 of Figure 1.

From examination of Figure 1, no specific structure is clearly associated with reference number 1, therefore, it is considered unclear what structure is being claimed by the term “hook” in

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the above recitation. It is also considered unclear what is meant by the word "hooking" in the above recitation.

D) The meaning of the last two lines of claim 3 is considered unclear.

E) Claim 4 recites "a distal of the buckle". It is considered unclear which portion of the buckle Applicant is referring to by this recitation.

#### ***Allowable Subject Matter***

11. Claim 1 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, second paragraph, claim objections and 35 USC 101 rejections set forth in this Office action.

12. Claims 2-4 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, second paragraph, claim objections and 35 USC 101 rejections, as applicable, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### ***Reasons for Allowance***

13. The following is an Examiner's statement for the reason for allowance of independent claim 1.

Claim 1 recites the limitation (as paraphrased due to claim objections and 112 2<sup>nd</sup> paragraph rejections) of a skate comprising a front seat, a rear seat and a buckle structure for

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connecting the front seat and the rear seat, wherein the buckle structure is installed in a round lower cover and the buckle has a stepped elliptical hole. This limitation, in combination with the other limitations of claim 1 were not found in the prior art.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

*Examiner's Comments*

14. As noted, claims 1-4 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claims are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claims must be in one sentence form only. Note the format of the claims in the cited prior art. While Applicant has made a "decent" attempt to write properly structured claims, objections and rejections set forth in this Office Action point to the fact that further improvement is necessary.

15. It appears that the Applicant in this applicant is a *pro se* (an inventor filing the application alone without the benefit of a Patent Attorney or Agent). Applicant may not be aware of the

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preferred methods of ensuring timely filing of responses to communications from the Office and may wish to consider using the Certificate of Mailing or the Certificate of Transmission procedures outlined below.

#### CERTIFICATE OF MAILING

To ensure that the Applicant's mailed response is considered timely filed, it is advisable include a "certificate of mailing" on the least one page (preferably on the first page) of the response.

This "certificate" should consist of the following statement:

I hereby certify that this correspondence is being deposited  
with the United States Postal Service as first class mail in an  
Envelope addressed to "Commissioner of Patents and  
Trademarks, Washington, DC 20231" on (date)  
(Typed or printed name of the person signing this certificate)

(signature)

#### CERTIFICATE OF TRANSMISSION

Alternatively, if Applicant wishes to respond by facsimile, rather than by mail, another method to ensure that the Applicant's response is considered timely filed, is to include a "certificate of transmission" on at least one page (preferably on the first page) of the response. This method

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should be used by foreign applicants without access to the U.S. Postal Service. This "certificate" should consist of the following statement:

I hereby certify that this correspondence is being facsimile transmitted  
to the United States Patent and Trademark Office,  
Fax No. (703)\_\_\_\_ - \_\_\_\_\_ on (date).

(Typed or printed name of the person signing this certificate)

(signature)

These "Certificates" may appear anywhere on the page, and may be handwritten or typed. They must be signed, and the date must be the actual date on which it is mailed or transmitted. For the purpose of calculating extensions of time, the date shown on the certificate will be construed as the date on which the paper was received by the Office, regardless of the date the U.S. Postal Service actually delivers the response, or the fax is "date-stamped" in. In this way, postal or transmission delays do not affect the extension-of-time fee.

In the event that a communication is not received by the Office, Applicant's submission of a copy of the previously mailed or transmitted correspondence showing the originally signed Certificate of Mailing or Transmission statement thereon, along with a statement from the person signing the statement which attests to the timely mailing or transmission date of the correspondence, would be sufficient evidence to entitle the Applicant to the mailing or transmission date of the correspondence as listed on the Certificate of Mailing, or Transmission, respectively.



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*Conclusion*

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- A) Hall - teaches an adjustable skate
- B) Pardon, et al - teaches an adjustable skate
- C) Goodman - teaches an adjustable skate
- D) Olivieri - teaches an adjustable skate
- E) Cheng - teaches an adjustable skate
- F) Gorza, et al - teaches an adjustable skate
- G) Edgerley, et al - teaches an adjustable skate
- H) Fisher, et al - teaches an adjustable skate
- I) Sauter, et al - teaches an adjustable skate
- J) French Patent 2672812 - teaches an adjustable skate

17. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Bryan Fischmann whose telephone number is (703) 306-5955. The examiner can normally be reached on Monday through Friday from 7:30 to 4:00.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson, can be reached on (703) 308-0885. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

*B. Fischmann 2-20-03*  
**BRYAN FISCHMANN**  
**PATENT EXAMINER**